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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,485	01/28/2002	Tetsuya Kusagawa	0445-0317P	5643
2292	7590	07/02/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			REICHLE, KARIN M	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/056,485	<b>Applicant(s)</b> KUSAGAWA ET AL.	
	<b>Examiner</b> Karin M. Reichle	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) 4,6-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-19-04 has been entered.

### ***Election/Restrictions***

2. This application contains claims directed to the following patentably distinct species of the claimed invention: the species of Figures 1-4 and the species of Figures 5-8.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Mr. Bob Gnuse on June 18, 2004 a provisional election was made without traverse to prosecute the invention of species of Figures 1-4, claims 1, 3 and 10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4, 6-9 and 11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

### ***Drawings***

5. The drawings were received on 4-19-04. These drawings are approved by the Examiner.

***Claim Objections***

6. Claims 1, 3 and 10 are objected to because of the following informalities: in claim 1, line 13, “which” should be --while such--. In claim 10, “fixed” should be --fixable--. Appropriate correction is required.

***Claim Language Interpretation***

7. The term “upstanding” is defined by the American Heritage Dictionary as “standing erect or upright.” Applicants do not specifically define the term “connects”. Therefore such term is given its common, i.e. dictionary, definition, i.e. includes both direct and indirect connections.

***Claim Rejections - 35 USC § 102/103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mizutani et al ‘140.

Claim 1: See Figures 1-3, i.e. the oblong absorbent article is 1, the absorbing layer is 12, the leak proof layer is 11, the standing gathers are 5. The gathers 5, see, e.g., col. 5, lines 54-58, include an “upstanding” portion, see Claim Interpretation Section *supra* (Note the claim language does not require the upright portion to be linearly upright) and element 15, which extends between a portion near an adjacent longer side edge of the absorbing layer and a portion 16 which portion is elastically extensible, see col. 6, lines 24-39, is substantially parallel to the absorbing layer and comes into planar contact with a wearer’s skin when worn, see, e.g., col. 5, lines 55-58, col. 8, lines 35-45 and col. 10, lines 13-20, i.e. is maintained in steric shape, i.e. the skin contacting portion 16 is maintained planar. As set forth at, e.g., col. 5, lines 30-57 and col. 6, lines 25-58, col. 7, lines 58-62, col. 7, line 60-col. 8, line 4, col. 8, lines 18-24, the portion 16 is disclosed as being made of a sheet 20 and at least one elastic member 7 which is fixed to the sheet discretely at 20b in the longitudinal direction thereof while in a stretched state and the parts of the sheet where the elastic member is not fixed are raised by contraction of the elastic member to form a plurality of hollow ridges 20a parallel to each other on a side of the skin contactable portion across the width of the portion 16, i.e. in a linear manner along the contraction direction of the elastic member and extending across the contraction direction of the member.

Claim 1 now requires, as best understood, that the sheet be planar when it is fixed to the elastic member. However it is the Examiner’s first position that such is set forth at col. 6, lines 7-9 and 25-39 of Mitzutani. In any case, and the Examiner’s second position, claim 1, lines 12-19 of claim 1 recite a product by process. As set forth in MPEP 2113, determination of patentability is based on the product of a product by process claim not on the method of production. If the product in the product by process claim is the same or obvious from a product

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of the prior art, the claim is unpatentable even though the prior product was made by a different process. The end product of the claim is a contracted elastic member discretely fixed to the sheet and a plurality of hollow ridges parallel to each other and perpendicular to the elastic between the points of fixation. The end product of Mizutani and the end product of the claim appear to be the same or similar, i.e. "obvious", even though they are produced by different processes and therefore the product of the instant claims does not patentably distinguish over the product of Mizutani.

Claim 3: The portion 15 connects a middle in a width direction of said elastically extensible portion 16, i.e. it connects such middle to the remainder of the article. It is noted the claim no longer claims connection to the middle region and note "connects" as set forth in the Claim Interpretation Section *supra*.

Claim 10: This claim recites capability, function or property of the structure claimed in claim 1, i.e. no additional structure is claimed. The Mizutani et al device includes all the claimed structure. Therefore, there is sufficient factual evidence to reasonably conclude that the capability, function or property would also be inherent in the same structure of Mizutani et al. See MPEP 2112.01.

### ***Claim Rejections - 35 USC § 103***

11. Claims 1, 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor '972 in view of Boberg '398 and Correa et al '386.

Claim 1: See Figures, i.e. the oblong absorbent article is 10, the absorbing layer is 20, the leak proof layer is 22, the standing gathers are 12. The gathers 12, see, e.g., abstract, include an

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“upstanding” portion, see Claim Interpretation Section *supra* (Note the claim language does not require the upright portion to be linearly upright) and element 36, which extends between a portion near an adjacent longer side edge of the absorbing layer and a portion 40 which portion is elastically extensible, see paragraph bridging pages 9-10, is substantially parallel to the absorbing layer and comes into planar contact with a wearer’s skin when worn, see, e.g., page 10, lines 2-3, i.e. the skin contacting portion 40 is maintained planar. As also set forth in the paragraph bridging pages 9-10, the portion 40 is disclosed as being made of a sheet, e.g. 18, and at least one elastic member 48 which is fixed to the sheet in the longitudinal direction thereof while in a stretched state and parts of the portion 40 are raised by contraction of the elastic member to form a plurality of ridges parallel to each other on a side of the skin contactable portion across the width of the portion 40, i.e. in a linear manner along the contraction direction of the elastic member and extending across the contraction direction of the member, see Figures. Therefore, the Taylor device clearly includes all the claimed structure except for the elastic member being discretely attached to the sheet such that the ridges formed thereby are hollow upon contraction of the elastics. The reference is silent as to whether the elastics are continuously or discontinuously, i.e. discretely, attached to the sheet to form the ridges seen in the Figures. However, see Boberg ‘398 at, e.g., page 14, lines 16-32 which teaches discontinuous or discrete attachment of elastic members to a sheet is interchangeable with continuous attachment and Correa et al ‘386 at, e.g., Figures 1a and 2a and the paragraph bridging cols. 7-8 which teaches a pad attaining a curved shaped due to elastics attached by discrete attachment to a sheet such that when the elastics are contracted to form the curved shape the ridges which are formed are hollow. Therefore to make the attachment of the elastic 48 to



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the sheet 18 of Taylor discrete attachment (if not already) would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by Boberg et al. In so doing, the resultant ridges of the modified Taylor device would be hollow as taught or evidenced by Correa et al.

Claim 3: The portion 36 connects a middle in a width direction of said elastically extensible portion 16, i.e. it connects such middle to the remainder of the article. It is noted the claim no longer claims connection to the middle region and note "connects" as set forth in the Claim Interpretation Section supra.

Claim 10: see page 8, lines 2-7.

### ***Response to Arguments***

12. Applicants remarks with regard to form have been considered but are either deemed moot in that the issues addressed have not been reraised or are deemed not persuasive for the reasons set forth supra. It is noted that Applicant's remarks with regard to claim 9 on page 1 are correct. Applicant's remarks with respect to the art have been considered but are either deemed not persuasive with regard to claims 1, 3 and 10 and the Mizutani reference for the reasons set forth supra or are merely noted with regard to claims 4, 6-9 and 11 which are drawn to the nonelected species.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art '278, '301 and '458 are further cited to teach the use of discrete


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attachment for attaching elastics to a sheet. The '029 reference is the US equivalent of a reference already of record.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 308-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
June 22, 2004